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10/036,054	12/31/2001	Clifford A. Pickover	YOR920010488US1	3936

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EXAMINER

BOUTAH, ALINA A

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/036,054

Applicant(s)

PICKOVER ET AL.

Examiner

Alina N Boutah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-26,28-34,36-53,55-61,63-80 and 82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-26,28-34,36-53,55-61,63-80 and 82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to Applicant's amendment filed November 16, 2005. Claims 1-7, 9-26, 28-34, 36-53, 55-61, 63-80 and 82 are pending in the present application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-26, 28-34, 36-53, 55-61 and 63-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,999,932 issued to Paul in view of USPN 6,324,569 issued to Ogilvie et al. (hereinafter referred to as Ogilvie).

(Amended) Regarding claim 1, Paul teaches a computer implemented method in a computer system for marking particular types of communications, said method comprising the steps of:

establishing a database of a plurality of different distinguishing identifiers, wherein each of said plurality of identifiers identifies a particular type of communication (figure 1: 102; col. 1, lines 9-20; col. 3, lines 37-52);

receiving a communication (abstract; col. 3, lines 54-64);

determining, by the computer system, if said communication includes one of said plurality of different identifiers (abstract; col. 2, lines 20-30);

marking said communication responsive to a determination that said communication does include one of said plurality of different identifiers (abstract; col. 2, lines 40-47; col. 3, line 66 to col. 4, line 11);

forwarding said communication responsive to a determination that said communication does not include one of said plurality of different identifiers (col. 8, lines 55-67); and

storing said identifier as one of said plurality of identifiers in said database (col. 8, lines 55-67).

However, Paul fails to explicitly teach: determining by the computer system whether said communication was deleted without being opened; and determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened.

Ogilvie teaches: determining by the computer system whether said communication was deleted without being opened (col. 6, lines 21-24); and determining an identifier included within said communication, responsive to a determination that said communication was deleted without being opened (col. 5, lines 27-45).

At the time the invention was made, one of ordinary skill in the art would have been motivated to combine the teaching of Ogilvie with the teaching of Paul in order to provide

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control over message removal therefore lessen burden off of recipients (Ogilvie: col. 2, lines 14-22).

Regarding claim 2, Paul teaches the method according to claim 1, further comprising the step of forwarding said marked communication (col. 3, line 66 to col. 4, line 11).

Regarding claim 3, Paul teaches the method according to claim 1, further comprising the steps of:

receiving a communication within a server computer system intended to be received by a recipient's computer system (figure 2; abstract; col. 3, lines 54-64; col. 6, lines 51-65);

determining within a server computer system if said communication includes one of said plurality of different identifiers (abstract; col. 2, lines 20-30);

in response to a determination that said communication does include one of said plurality of different identifiers, marking, utilizing said server computer system, said communication (abstract; col. 2, lines 40-47; col. 3, line 66 to col. 4, line 11); and

forwarding said marked communication from said server computer system to said recipient's client computer system (col. 3, line 66 to col. 4, line 11).

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Regarding claim 4, Paul teaches the method according to claim 3, further comprising the steps of:

receiving a communication within a service bureau in a server computer system intended to be received by a recipient's computer system (col. 1, lines 22-54; figure 2; abstract; col. 3, lines 54-64; col. 6, lines 51-65);

determining within said service bureau in said server computer system if said communication includes one of said plurality of different identifiers (abstract; col. 2, lines 20-30);

in response to a determination that said communication does include one of said plurality of different identifiers, marking, utilizing said service bureau in said server computer system, said communication (abstract; col. 2, lines 40-47; col. 3, line 66 to col. 4, line 11); and

forwarding said marked communication from said service bureau in said server computer system to said recipient's client computer system (col. 3, line 66 to col. 4, line 11).

Regarding claim 5, Paul teaches the method according to claim 4, further comprising the step of compensating said service bureau (col. 5, line 51).

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Regarding claim 6, Paul teaches the method according to claim 1, further comprising the step of establishing said database of said plurality of different distinguishing identifiers, wherein each of said plurality of identifiers identifies an unwanted communication (abstract).

Regarding claim 7, Paul teaches the method according to claim 1, further comprising the step of deleting marked communications before said marked communications are forwarded to their intended recipients (col. 5, lines 18-32).

Regarding claim 9, Paul teaches the method according to claim 1, further comprising the step of publishing said plurality of identifiers included within said database (figure 4).

Regarding claim 10. Paul teaches the method according to claim 1, further comprising the step of subscribing to a service that provides said plurality of identifiers (col. 5, lines 18-32).

Regarding claim 11, Paul teaches the method according to claim 1, further comprising the step of forwarding said communication to a special folder designated for receiving communication that are said particular type (col. 9, lines 8-19).

Regarding claim 12, Paul teaches the method according to claim 1, further comprising the step of notifying a sender of said marked communication to discontinue communications to an intended recipient of said marked communication (col. 4, lines 41-58).

Regarding claim 13, Paul teaches the method according to claim 12, further comprising the step of blocking further communications from said sender (col. 1, lines 43-54).

Regarding claim 14, Paul teaches the method according to claim 1, further comprising the step of establishing said database of said plurality of different distinguishing identifiers, each one of said plurality of identifiers identifying a sender (col. 9, lines 20-29).

Regarding claim 15, Paul teaches the method according to claim 1, further comprising the step of establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a total number of times communications have been received from a sender who transmitted said marked communication (col. 5, lines 5-17).

Regarding claim 16, Paul teaches the method according to claim 1, further comprising the step of establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a particular text string (col. 4, lines 34-40).



Regarding claim 17, Paul teaches the method according to claim 1, further comprising the step of establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a number of intended recipients (figure 2: 201).

Regarding claim 18, Paul teaches the method according to claim 1, further comprising the step of establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a particular sender (figure 2).

Regarding claim 19, Paul teaches the method according to claim 1, further comprising the step of establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a particular return address (figure 5).

Regarding claim 20, Paul teaches the method according to claim 1, further comprising the step of establishing said database of said plurality of different distinguishing identifiers, one of said plurality of identifiers identifying a particular language (col. 9, lines 7-19).

Regarding claim 21, Paul teaches the method according to claim 1, further comprising the step of establishing said database of said plurality of different distinguishing identifiers, one of

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said plurality of identifiers identifying a particular Internet service provider source (col. 1, lines 31-42).

Regarding claim 22, Paul teaches the method according to claim 1 wherein said communication comprises at least one of e-mail, instant messaging, XML messages, EDI messages, facsimiles, telephone communications, commercial messages, postal mail, packaging material, or digital images (abstract).

Regarding claim 23, Paul teaches the method according to claim 22, further comprising the step of determining if said communication is an unsolicited communication (abstract).

Regarding claim 24, Paul teaches the method according to claim 1, wherein said communication comprises adult material (col. 1, lines 43-54).

Regarding claim 25, Paul teaches the method according to claim 22, wherein said step of marking said communication further comprises the step of marking said communication utilizing at least one of: adding text to a subject line; sending a message or note to an e-mail application identifying a particular communication as possibly unwanted; embedding the suspected unwanted communication in another note; changing at least one attribute of a portion of the

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communication text; changing the color of the subject line; changing non-textual attributes of the communication; adding an icon; adding a symbol; positional marking; marking for investigation; forwarding to a third-party; or issuing a report (figure 4; col. 8, lines 17-34).

Regarding claim 26, Paul teaches the method according to claim 1 wherein said step of marking said communication further comprises the step of marking said communication utilizing at least one of: adding text to a subject line; sending a message or note to an e-mail application identifying a particular communication as possibly unwanted; embedding the suspected unwanted communication in another note; changing at least one attribute of a portion of the communication text; changing the color of the subject line; changing non-textual attributes of the communication; adding an icon; adding a symbol; positional marking; marking for investigation; forwarding to a third-party; or issuing a report (figure 4; col. 8, lines 17-34).

Claims 28-34, 36-53 and claims 55-80 are similar to claims 1-26, respectively, therefore are also rejected under the same rationale.

Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Ogilvie, in further view of USPAP 2005/0144238 by Morin et al. (hereinafter referred to as Morin).

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Claim 82 is similar to claim 1, further including a step of: incrementing a counter associated with a sender of a communication including an identifier stored in said database of identifiers, wherein said counter can be used to identify a sender who often sends unwanted communications in which is not taught in the Paul or the Ogilvie references. However, this is taught in Morin in paragraphs 0041 and 0043. At the time the invention was made, one of ordinary skill in the art would have been motivated to combine the teaching of Morin with the teachings of Paul and Ogilvie in order to keep track of the number messages received, therefore ensuring that the number of unsolicited messages is under control.

### ***Response to Arguments***

Applicant's arguments filed November 16, 2005 have been fully considered but they are not persuasive.

On November 4, 2005, during a telephone interview, the Examiner suggested that an amendment to claim 1 clarifying who is determining whether a communication is deleted without being opened as well as an amendment to claim 82 to further clarify the claimed counter as set forth in page 12, lines 1-5 of Applicant's specification (see Interview Summary mailed November 14, 2005).

Applicant has amended claim 1 to clarify that a computer system is determining whether a communication is deleted without being opened. However, by merely disclosing that a computer system is performing all of the steps in claim 1 is not enough to overcome the prior art as cited. Paul-Oilvie combination teaches a computer system that teaches the steps as claimed (see cited areas in the rejection above). Applicant is suggested to further amend the claims to

clarify who (in this case, the client or server) is performing all the steps in claim 1 to further put the application in better condition to overcome the cited prior arts.

Applicant has also amended claim 82 to further clarify that the counter can be used to identify a sender who often sends unwanted communications. Morin teaches a system that checks how many complaints have been associated with user's account by querying a complaint counter (see paragraph 0043 of Morin). By querying the counter, a SPAM abuser can be determined. Therefore, the teaching of Morin reads onto Applicant's amended claim 82. Had Applicant amended claim 82 as suggested (defining "counter" as defined in page 12, lines 2-5: "a counter can be established for each sender of a communication that includes an identifier already included in the database or an identifier determined from a communication that was deleted without opening," it would have put the application in better form to overcome the cited prior arts.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**JEFFREY PWU**  
**PRIMARY EXAMINER**